

Serial No. 10/047,584

In the Drawings:

Enclosed is a substitute drawing sheet for Fig. 4 for entry into the file. Please delete existing Fig. 4 and replace with the enclosed replacement Fig. 4.

Serial No. 10/047,584

REMARKS

This amendment is responsive to the office action dated December 16, 2004.

Claims 1-19 were pending in the application. Claims 1, 5, 6, 11 and 12 were rejected. Claims 17-19 were allowed by the Examiner and Claims 2-4, 7-10 and 13-16 were objected to.

By way of this amendment, the Applicant has submitted a replacement Fig. 4.

Claims 6 and 12 have been amended. Claims 1-5, 7-11 and 13-19 remain unchanged.

Accordingly, Claims 1-19 are currently pending.

I. **OBJECTION TO CLAIMS:**

Claims 6 and 12 were objected to because in line 4 of each claim the word "said" was repeated. The Applicant has amended these claims to delete the second and duplicative occurrence of the word said in each claim. Withdrawal of this objection is respectfully requested.

II. **OBJECTION TO DRAWINGS:**

The drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner stated that the claimed features of:

the channel having a bottom wall and a side wall extending upwardly between said bottom wall and said top surface with an opening in said side wall at said back end of said housing, said channel having mating formations adapted to slideably receive a secondary tool through said opening in said side wall.

are not shown in the drawings and therefore the drawings are objected to.

Tuning to the specification in connection with drawing Figs. 3, 4 and 5, the Applicant asserts that each and every claimed feature is shown, fully designated and described both in the specification and indicated properly by reference numerals in the

Serial No. 10/047,584

drawings. The Applicant has made a clarifying amendment to Paragraph 18 and added three reference numerals to Fig. 4 to further clarify this matter.

Paragraph 17 of the specification reads as follows:

Turning to Figs. 3 and 4, the channel opening 20 in the surface of the flashlight housing 15 is preferably configured to interfittingly mate with the size and shape of the side covers 22 of the pocket knife 12. The channel 20 is configured with a bottom wall 28, two parallel side edges and a radiused inner end forming a side wall of the channel 20. In this manner, when the pocket knife 12 is slidably received into the channel 20 of the flashlight housing 15, one of the side covers 22 of the knife 12 is positioned in flush relation with the flat surface 18 in the housing 15.

Further Paragraph 18 as amended provides:

It can be seen in these two figures that two distinct features cooperate to receive and retain the pocket knife 12 within the channel 20. First, a groove 24 is provided in the sidewalls of the channel 20. These grooves 24 are an important feature of the present invention 10. As previously discussed and as can be seen in Fig. 4, the retractable blades 26 on the pocketknife 12 protrude slightly from the peripheral edges of the pocketknife 12 in their retracted position. The grooves 24 are located in such a manner that they receive these retracted blades 26 as the knife 12 is pushed into the channel 20 and engage the blades 26 to retain the knife 12 within the channel 20. The cooperative engagement of the grooves 24 and the blades 26 prevent the knife 12 from movement out of the open top of the channel 20. The relationship between the pocket knife 12, the housing 15, channel 20 and the grooves 24 is best illustrated in Fig. 5. The retracted blades 26 are shown engaged in the grooves 24 in the side wall 25 of the channel 20 and the side casing 22 of the knife 12 can be seen to be received flush with the surface 18 of the housing 14. Accordingly, the channel 20 can be seen to have a bottom wall 28 and a side wall 25 extending upwardly between said

Serial No. 10/047,584

bottom wall 28 and said top surface 18 with an opening 23 in said side wall 25 at said back end 27 of said housing 14, said channel 20 having mating formations 24 adapted to slideably receive a secondary tool (pocket knife) 12 through said opening 23 in said side wall 25.

Turning therefore to the claimed elements, it is clear that each element is shown and disclosed in the drawing figures as follows:

the channel (20) having a bottom wall (28) and a side wall (25) extending upwardly between said bottom wall (28) and said top surface (18) with an opening (23) in said side wall (25) at said back end (27) of said housing (14), said channel (20) having mating formations (24) adapted to slideably receive a secondary tool (12) through said opening (23) in said side wall (25).

Therefore, the Applicant asserts that all claimed elements are shown, illustrated in the drawings and fully supported. Withdrawal of this objection is respectfully requested.

III. REJECTION OF CLAIMS UNDER 35 USC 102

Claims 1, 11 and 12 were rejected under 35 USC 102(b), as being anticipated by US Patent No. 6,334,693 (Lee). The Examiner stated that Lee discloses a housing with a front end, a back end a top surface, a channel configured with complementary formations to slidably receive a tool and a closure element.

The present invention in Claim 1, 11 and 12 all include claimed limitations that the housing that is configured to slidably receive a tool into a channel that extends into the rear portion of the housing. The channel further requires an opening at the rear of the housing through which the tool is slid into the channel. The present invention clearly provides an opening in the rear of the housing to receive the pocketknife and a closure element is placed into position at the rear of the housing. By allowing the tool to be slid

Serial No. 10/047,584

into the housing from the rear, a small opening is required and a much smaller closure element is necessary to retain the tool in the housing.

By way of contrast, the Lee device includes a channel into which the flashlight tool is placed via an opening in the side with a closure cover clamping over the side of the device. A very large opening is provided which in turn requires a large closure panel. This large operable closure component is easily broken or subjected to damage creating an undesirable feature as compared to the claimed device of the present invention.

Since the present invention recites claimed subject matter that is not disclosed in Lee, the Lee reference cannot anticipate the present invention under §102(b). Accordingly, this rejection is not believed to be maintainable or applicable. Reconsideration, and withdrawal of the rejection is respectfully solicited.

IV. REJECTION OF CLAIMS UNDER 35 USC 103

Claims 5 and 6 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,334,693 (Lee). The Examiner stated that Lee discloses a housing with a front end, a back end a top surface, a channel configured with complementary formations to slidably receive a tool and a closure element. The Examiner has stated that although Lee does not demonstrate a secondary compartment in the housing it would have been obvious to have provided a secondary compartment in the Lee device therefore rendering the present invention obvious.

The present invention in Claim 5 however includes disclosure related to the secondary compartment that includes claimed limitations that the housing that is configured to slidably receive a tool into a channel that extends into the rear portion of the housing. The channel further requires an opening at the rear of the housing through which the tool is slid into the channel. The present invention clearly provides an opening in the rear of the housing to receive the pocketknife and a closure element is placed into position at the rear of the housing. By allowing the tool to be slid into the housing from the rear, a small opening is required and a much smaller closure element is necessary to retain the tool in the housing. Further, the primary compartment is provided to receive another primary tool component.

Serial No. 10/047,584

By way of contrast, the Lee device includes a channel created in the handle portion of a wrench. The channel in the handle receives the flashlight tool via an opening in the side with a closure cover clamping over the side of the device. A very large opening is provided which in turn requires a large closure panel. This large operable closure component is easily broken or subjected to damage creating an undesirable feature as compared to the claimed device of the present invention. Further, one skilled in the art could not simply add an additional compartment for receiving a primary tool. The primary tool is the wrench into the handle of which the Lee channel is formed. The addition of another channel for receiving another tool would inhibit the primary function of the Lee device and that is to function as a wrench. One skilled in the art would lack the motivation to make such an addition because of the detrimental effect the addition would have on the performance of the tool. Therefore, it would not have been obvious to one skilled in the art to make this simple substitution

Applicants note that "Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior references, combining the right reference in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Corp., 5 USPQ2d 1788 (Fed. Circ. 1988). The Appellants submit that the Examiner has used improper hindsight in reconstructing the invention. To give a skilled artisan the two cited references alone, without also giving him the particular problem to be solved, would not provide any motivation to combine the features to result in the claimed invention. While clearly one could assemble virtually any known device from a combination of prior devices by simply picking and choosing the appropriate constituent elements from prior art references, the standard of law requires that the references provide some basic teaching or suggestion that would motivate the combination. There is simply nothing explicit or implicit in Lee that would motivate someone skilled in the art to simply add additional compartments for storage of additional tools as cited by the Examiner without first having knowledge of the Appellant's intended device. The combination would simply not be obvious from a reading of only the cited references. The wholesale and random replacement of elements without motivation or teaching is clearly improper under the law. Therefore reconsideration and withdrawal of this rejection is respectfully requested.

Serial No. 10/047,584

V. ALLOWABLE SUBJECT MATTER

The Examiner indicated that Claims 2-4, 7-10 and 13-16 were allowable if rewritten in independent form. Claims 17-19 were fully allowed.

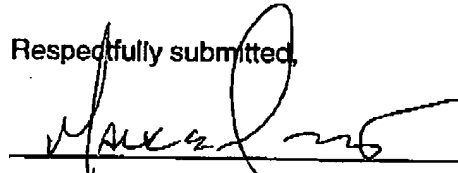
VI. CONCLUSION

Accordingly, claims 1-19 are believed to be in condition for allowance and the application ready for issue.

Corresponding action is respectfully solicited.

PTO is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our account #02-0900.

Respectfully submitted,



Mark E. Tetreault, Esq.
Reg. No. 48,289

BARLOW, JOSEPHS & HOLMES, Ltd.
101 Dyer Street, 5th Floor
Providence, RI 02903
(401) 273-4446 (tel)
(401) 273-4447 (fax)
met@barjos.com